

or suggested in the prior art. As a review, the Applicants have surprisingly found that a specific combination of a protease inhibitor, a cell differentiation enhancer, and a self-tanning agent, DHA, are highly effective in stimulating the repair of a damaged lipid barrier, and therefore, are shown to be useful as well in maintenance of a normal and healthy lipid barrier, as exemplified in independent claim 15.

In contrast, Simon merely discloses a laundry list of possible actives that may be used in a composition. Specifically, Simon lists numerous broad categories of actives, as well as over 60 specific actives, including variations of such actives. Simon offers no teaching or even mere suggestion as to which combinations would be effective in a topical solution. Instead, Simon teaches a multitude of different materials that could be used alone or in any random combination, leading to a possibility of thousands if not millions of combinations. A person of ordinary skill in the art would have no motivation to randomly select three specific types of ingredients from the vast number of actives listed in Simon absent hindsight reconstruction using the Applicants' claims. The fact that a claimed compound may be encompassed by a disclosed generic formula does not by itself render that compound obvious. See *In re Jones*, 958 F.2d 347, 350, 21 U.S.P.Q.2d 1941, 1943 (Fed. Cir. 1992). Moreover, a generic disclosure having many variables, and encompassing millions of different species, does not render obvious a combination of three specific compounds, absent some motivation to select the specific species claimed. See *In re Baird*, 16 F.3d at 382, 29 U.S.P.Q.2d at 1552 (The Court found no evidence of motivation to select the claimed species, because there was nothing in the disclosure of the prior art suggesting that one should select such variables in a formula having many variables, encompassing more than a 100 million different diphenols, only one of which

was bisphenol A. Therefore, the Court held that the prior art disclosure of millions of compounds does not render obvious a claim of three compounds.)

For the aforementioned reasons, the Applicants submit that Simon does not render independent claim 15 unpatentable as obvious. The Applicants therefore respectfully request that claim 15 be passed to issuance. Since claim 28 teaches the composition of claim 15, which is believed to be patentable for the reasons explained above, claim 28 should also be found allowable and be passed to issuance.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Simon as applied to claims 15, 28-30 above, and further in view of Elias et al (U.S. Patent No. 5,885,565) (“Elias”). Since claims 15 and 28 are believed to be patentable for the aforementioned reasons and Elias does not provide the deficiencies in Simon (providing no suggestion for the specific combination claimed), the Applicants submit that claim 10 is nonobvious in light of the prior art. Claims 30-32 depend from Claim 10, which is believed to be patentable. Therefore, claims 30-32 should also be found patentable and be passed to issuance.

REJECTION OF CLAIMS 2, 3, 6-8, 16, 17, 20, 23, 26 & 33-36 UNDER 35 U.S.C. §103

The Office Action rejected claims 2, 3, 6-8, 16, 17, 20, 23, 26 and 33-36 under 35 U.S.C. 103(a) as being unpatentable over Simon et al. as applied to claims 15, 28-30, 32 above, and in further view of Subbiah (U.S. Patent No. 6,150,381) (“Subbiah”). Specifically, the Office Action states:

Simon teaches all that is recited by claims 2, 3, 6-8, 16, 17, 20, 23, 26, 33-36 except for the invention comprising sclareolide and instant amounts of ingredients. However, Subbiah teaches a composition for skin application comprising sclareolide. See column 3 line 20 – column 4 line 65. It would have been obvious to one having ordinary skill in the art to modify the invention of Simon to include sclareolide. One would have been motivated to do this since both inventions are applied topically to treat dermal disorders.

Office Action, pp. 2-3.

As discussed above, Simon provides no teaching or suggestion for the combination disclosed in claims 15, 28-30 or 32. Subbiah does not supply the deficiencies in Simon, since Subbiah makes no reference to combining the specific ingredients in Applicants' claim 15. Therefore, the Applicants submit that the Examiner has again failed to establish a *prima facie* case of obviousness and respectfully request that the claims be passed to issuance.

CLAIM OBJECTIONS

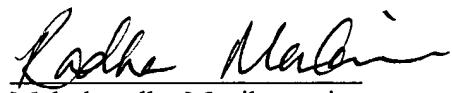
The Office Action indicated that claims 4, 9, 11-13, 18, 19, 21, 22, 24, 25, and 31 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The Office Action admitted that the prior art does not teach or suggest the invention comprising the limitations of the objected claims.

The Applicants believe further amendments are not required in light of the foregoing arguments. However, the Applicants reserve the right to amend the claims as requested.

Conclusion

In view of the foregoing arguments, the present claims are believed to be in condition for allowance, and prompt issuance of a Notice of Allowance is respectfully solicited. The Examiner is encouraged to contact the undersigned by telephone if it is believed that discussion will resolve any outstanding issues.

Respectfully submitted,



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